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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH BACH

Appeal 2010-001955
Application 09/327,085
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-2, 5, and 6, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is directed to a method of soliciting and receiving orders for merchandise over the radio or Internet (Spec. 1:6-9). Claim 1, reproduced below with the numbering in brackets added, is representative of the subject matter of appeal.

1. An interactive audio system, comprising:
a home audio system having a user interlace;
a communication device connecting said home audio system to a telephone:
an audio player receiving music signal and audibly playing music pieces from said music signal;
[1] a rider buffer storing data corresponding to said music pieces;
[2] a main processor receiving a programming signal and a rider signal from a program transmission channel and directing said programming signal to the audio player and storing the rider signal in the rider buffer;
[3] an ordering interrupter;
wherein upon receiving a command from the user interface, said ordering interrupter instructs the communication device to establish communication with an ordering center via said telephone, and places

an order for a hard copy of the music piece corresponding to the data stored in said rider buffer.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Noreen	US 5,303,393	Apr. 12, 1994
August	US 6,389,055 B1	May 14, 2002

The following rejections are before us for review:

1. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

2. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

3. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. § 103(a) as unpatentable over August and Noreen.

THE ISSUES

With regards to the rejections of the claims under 35 U.S.C. § 101, the issue turns on whether the claims are directed to non-statutory subject matter.

With regards to the rejections of the claims under 35 U.S.C. § 112, second paragraph, the issue turns on whether method recitations are present in the claim which render the claim indefinite.

With regards to the rejections under 35 U.S.C. § 103(a), the issue turns on whether the Examiner has presented a prima facie case that August discloses claim limitation [2] cited above.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:[1]

FF1. August has disclosed a method for combining digital data with a perceptible program signal. The method is useful in encoding purchase information or watermarking information into the signal. (Abstract).

FF2. August in Fig. 1 shows a program signal 12 combined with a data signal 16 to produce combined signal 19. The signal 19 is converted to acoustic signal 20. The acoustic signal 20 is received by a user 22 and also at the microphone 14 where a data signal 34 is extracted.

FF3. August in Fig. 5 shows the transmission of both a nondiscernable visual pattern and a nondiscernable audio signal from device 101. The signal 103 is received by device 101 and the nondiscernable audio signal played at speaker 106 and a visual pattern is played at 105. Fig. 5 fails to show the device 101 storing a rider signal in a rider buffer. Devices 101 and 110 are separate elements in the system.

FF4. August in Fig. 6 shows block diagram of the components of the device. August in Fig. 8 shows a flow diagram of the process by which data

[1] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

embedded in a non-discernable visual or non-audible message is captured and used (Col. 2:57-59).

FF5. August in Figs. 1, 5-6, and 8 does not disclose: a main processor receiving a programming signal and a rider signal from a program transmission channel and directing said programming signal to the audio player and storing the rider signal in the rider buffer. None of the cited Figures 1, 5-6, and 8, shows a specific reference to a rider buffer.

ANALYSIS

Rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112 (2nd paragraph)

The Examiner has determined that claims 1-2, 5, and 6 are unpatentable under 35 U.S.C. § 101 because the claims overlap two different statutory classes of invention by being directed to both a system and method (Ans. 3-4 and 7). The Examiner has also rejected these claims under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly and distinctly claim the subject matter regarded as the invention because the claim includes system and method recitations (Ans. 4, 7).

In contrast, the Appellant argue that the rejection of claims 1-2, 5, and 6 on both of these grounds in improper (Br. 5-7).

We agree with the Appellant. Claim 1 is directed to a "system" and the body of the claim contains many elements of the system such as a user interface, an audio player, and a main processor. The portions of the claim cited by the Examiner such as main processor "receiving", "directing", and "storing" (Ans. 7) are merely functions performed by the elements of the claimed apparatus. Including such functions of the system in the body of the claim here does not render the claim unpatentable under 35 U.S.C. § 101.

Similarly, the cited claims are not indefinite under 35 U.S.C. § 112, second paragraph. In claim 1, it is clear that the claim is drawn to a "system" and any included functions of the system's recited elements do not render the claim indefinite as it is clear that a "system" is what is being claimed. For these above reasons the rejection of claims 1-2, 5, and 6 under 35 U.S.C. § 101 and 35 U.S.C. § 112 (2nd paragraph) is not sustained.

Rejections under 35 U.S.C. § 103(a)

The Examiner has determined that claims 1-2, 5, and 6 are unpatentable under 35 U.S.C. § 103(a) under August and Noreen (Ans. 4-6, 8-9). The Examiner has determined that August discloses claim limitation [2] at Figs. 5-6, and 8 (Ans. 5, 8).

In contrast, the Appellant has argued that this rejection is improper because August fails to disclose claim limitation [2] (Br. 8-9).

We agree with the Appellant. Claim limitation [2] requires: "a main processor receiving a programming signal and a rider signal from a program transmission channel and directing said programming signal to the audio player and storing the rider signal in the rider buffer" and none of the cited Figs. 5, 6, or 8 in August disclose this (FF5). The Examiner has failed to present a prima facie case of obviousness by failing to specifically show where claim limitation [2] is present in the cited prior art. In Figure 5 of August, the reference does not show the device 101 to include storing a rider signal in a rider buffer and device 110 is a separate device (FF4). For these above reasons, the rejection of claim 1 and its dependent claims under 35 U.S.C. § 103(a) is not sustained.

DECISION

The Examiner's rejection of claims 1-2, 5, and 6 is reversed.

REVERSED

MP